

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re application of:

Madaline Chirica, et al.

Application No.: 10/667,290

Filed: September 18, 2003

For: DCRS5 POLYPEPTIDES (as amended)

Examiner: J. Seharaseyon

Art Unit: 1647

Conf. No.: 8667

MAIL STOP: Patent Extension

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT: GROUNDS UNDER 37 C.F.R. § 1.702 FOR THE ADJUSTMENT (37 C.F.R. § 1.705 (b)(2)(i) TO (iv))

Sir:

1. This statement is being submitted in support of the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)" to which this statement is attached.

37 C.F.R. § 1.705 (b)(2)(i)

2. The patent term adjustment shown on the Determination of Patent Term Adjustment Under 35 U.S.C. § 154(b) that was attached to the Notice of Allowance dated October 3, 2007 is 543 days. Applicants believe that this determination of 543 days is an error, due to failure to appreciate that the first requirement for restriction in the case had been vacated based on an Office error. It is respectfully submitted that the correct patent term adjustment under 37 C.F.R. § 1.702 is 713 days.

37 C.F.R. § 1.705 (b)(2)(ii)

3. The basis on which Applicants seek adjustment is as follows:

A. The application was filed, along with a Preliminary Amendment cancelling all original claims 1 – 23 and adding new claims 24 – 38, on September 18, 2003.

B. A Restriction Requirement was mailed May 15, 2006 based on the original (cancelled) claim set, not the claims actually pending at the time. This date is mistakenly used in the calculation of the 543 day PTA on the Notice of Allowance.

C. Applicant pointed out the error in a response dated August 15, 2006. This response was filed within 3 months of the mailing date of the Restriction Requirement, and thus does not constitute a failure to engage in reasonable efforts to conclude processing or examination of the application. 37 C.F.R. § 1.704(b).

D. The Examiner expressly vacated the May 15, 2006 Restriction Requirement and issued a new Restriction Requirement in an action mailed November 1, 2006. The date of this second Restriction Requirement is the date that should have been used to calculate the PTA of 713 days. 37 C.F.R. §§ 1.702(a)(1), 1.703(a)(1).

E. A first Notice of Allowance was sent on June 26, 2007, along with a notice that the patent term adjustment would be 543 days.

F. Applicants filed an RCE with an IDS on September 21, 2007.

G. A second Notice of Allowance¹ was sent on October 3, 2007, along with a notice that the patent term adjustment would be 543 days.

H. Accordingly, Applicants request that the PTA be calculated based on the difference between the filing date of September 18, 2003 and the date of the first action on November 1, 2006, less 14 months, i.e. 713 days.

37 C.F.R. § 1.705 (b)(2)(iii)

4. The present application is not subject to a Terminal Disclaimer.

37 C.F.R. § 1.705 (b)(2)(iv)

5. There were no circumstances in the present application constituting a failure to engage in reasonable efforts to conclude processing or examination of the application.

¹ In the interests of clarity, Applicants note out that the Detailed Action accompanying this second Notice of Allowance implies that the application was under final rejection when the RCE was filed, whereas the record indicates that the application had been allowed.

Applicants respectfully request a favorable decision on the patent term adjustment of 713 days in this case.

Respectfully submitted,

Date: 20 December 2007

By: *Gregory R. Bellomy*
Gregory R. Bellomy, Reg. No. 48,451
Attorney for Applicants

Customer No. 028008
DNAX Research, Inc.
901 California Avenue
Palo Alto, CA 94304-1104
Telephone (Switchboard): (650) 496-6400
Telephone No. (Direct): (650) 496-6565
Facsimile No.: (650) 496-1200